

Application No.: 10/766,366
Filing Date: 01/28/04
Docket No.: A0000367-03-ESW

REMARKS

Claims 1-19, 21-27 and 31-32 are pending in the present application. Claims 1-19, 21-27 and 31-32 are subject to a Restriction Requirement. Claims 1 or 28 are subject to an Election Requirement.

Restriction Requirement

The Examiner has stated that there are two inventions in the present application. The Examiner claims that Invention I (claims 1-19, 21-27 and 31-32) are drawn to an oral care composition and Invention II (claims 28-30) are drawn to a method of treating or preventing diseases or conditions of the oral cavity.

The Examiner is requiring under 35 U.S.C. 121 to elect one invention for examination.

Applicant respectfully traverses this requirement. Applicant contends that it would not be an undue burden for the Examiner to examine all of the oral disease treatments of the present application under the same search. Accordingly, applicant respectfully submits that the Examiner's restriction requirement under 35 U.S.C. 121 is improper and respectfully request that the requirement be withdrawn.

Notwithstanding the previous comments, should the Examiner maintain the restriction requirement, applicant provisionally elects, with traverse, Invention I (claims 1-19, 21-27 and 31-32).

Election of Species Requirement

The Examiner is requiring under 35 U.S.C. 121 to elect a single disclosed tropolone compound for prosecution on the merits. The Examiner notes that claims 1 or 28, depending on the elected group, is generic to a plurality of disclosed patentably distinct species comprising tropolone compound.

Applicant respectfully traverses this requirement. Under 35 U.S.C. 121, the Patent & Trademark Office has the authority to restrict an application to a single disclosed species where

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the claims cover two or more "independent and distinct" species. The tropolone compounds in the present application fail to meet this requirement; they are not "independent" (i.e., they do not lack commonality of design, operation or effect). All of the tropolone compounds in the present invention are functionally related and are used for the prevention or treatment of diseases and conditions of the oral cavity. Accordingly, applicant respectfully submits that the Examiner's election of species requirement under 35 U.S.C. 121 is improper and respectfully request that the requirement be withdrawn.

Notwithstanding the previous comments, should the Examiner maintain the election of species requirement, applicant provisionally elects, with traverse, hinokitiol as the species for prosecution. Claims 1-19, 21-27 and 31-32 as amended read on the elected species.

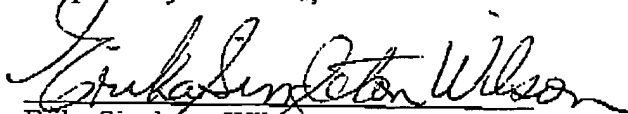
In view of the present Amendment and Response, Applicants respectfully request favorable reconsideration.

Should the Examiner have any questions or comments concerning the above, the Examiner is respectfully invited to contact the undersigned attorney at the number listed below.

Date

4/3/2006

Respectfully submitted,


Erika Singleton Wilson
Reg. No. 52,368

Warner-Lambert Company LLC
201 Tabor Road
Morris Plains, NJ 07950
Phone: 973-385-5564
FAX: 973-385-3117

Customer No.: 29668

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